

REMARKS

This invention provides for, *inter alia*, a process dispensing a paint, printing ink or pigment paste, an aqueous pigment concentrate and to coating system which involve or contain a copolymer based upon oxyalkyleneglycol-alkylene ethers or polyalkylene oxide alkenyl ethers and unsaturated dicarboxylic acid derivatives.

Entry of this Amendment is requested as it is directly responsive to the final rejection, does not add more claims than it cancels, and does not add subject matter that requires further consideration and search.

This Amendment cancels all the pending claims without prejudice or the intention of creating estoppel. Applicants reserve the right to file a divisional applications directed to the subject matter of claims 1 to 9, 20 to 22, and 24. Claims 25 to 34 primarily find support in original claims 10 to 19 and 23. Support for "polyalkylene oxide alkenyl ethers" is found on page 4 line 5. Thus, no new matter is added. The other changes were to the indentation, which are editorial and do not affect the search or the scope of the claims; Applicants made these changes in order to arrive at a reasonable compromise with the Examiner. As these claims do not narrow the scope of the claimed subject matter, the doctrine of equivalents is not affected.

Pursuant to 37 CFR 1.136(a) Applicants petition the Director to extend the time period to file this response by one (1) month. A check for \$ 110.00 is enclosed to cover the cost of this petition. It is believed that no further fee is required for the consideration of this Amendment. If, however, an additional fee is required, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account 50-0320.

Claims 1 to 19 and 23 stand rejected for allegedly being indefinite under 35 USC 112, second paragraph. Applicants respectfully disagree, especially in view of the new set of claims, and withdrawal of this rejection is respectfully requested.

While Applicants maintain that the indentations and the definition of $-NHR^2$ and $-NR^2_2$ would be understandable to one skilled in the art when read in light of the specification, the test for indefiniteness (*see, e.g., Hybritech Inc., v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986); *Morton Int. Inc. v. Cardinal Chem. Co.*, 28 USPQ2d 1190 (Fed. Cir. 1993); or *Orthokinetics Inc. v Safety Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986)), Applicants have amended the claims in order to reach a reasonable compromise with the Examiner. As further evidence that one skilled in the art would understand the structure of copolymers being claimed, the Examiner's attention is directed to U.S. Patent 5,978,425, of record, in which most of these copolymers are claimed without indentation and using the original wording for $-NHR^2$ and $-NR^2_2$. Hence, it is urged that the former claims would be understandable to one skilled in the art since this construction is used all the time in the art. Thus, in view of the foregoing, reconsideration and withdrawal of this portion of the rejection is requested.

With regard to the issue concerning the product *lm*, Applicants respectfully urge that one skilled in the art would understand which copolymers are being claimed since the skilled practitioner would read the terms "oxyalkylenealkylglycol-alkylene ethers" or "polyoxyalkylene oxide alkenyl ethers" as modifying copolymers containing the structural groups for formula Ia and/or Ib. Thus, if a compound which fell within formula Ia and/or Ib was not a oxyalkylene-alkylglycol-alkylene ether or polyoxyalkylene oxide alkenyl ether, then the skilled artisan would realize that this compound is not being claimed.

The rejection alleges that as it is possible to manipulate the structural formula Ia and/or Ib and form a compound that may not fall within the copolymer that is identified earlier in the text of the claim, the claims are indefinite and cannot be searched. Applicants respectfully disagree. Applicants urge that the terms “oxyalkylenealkylglycol-alkylene ethers or polyoxy-alkylene oxide alkenyl ethers” must be read in conjunction with each other and once the claims are read in this manner, they are not indefinite.

It is well established that “claims are not to be considered in a vacuum, ‘but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art’.” *In re Kroeckel*, 183 USPQ 610, 612 (Fed. Cir. 1974) (quoting *In re Moore*, 169 USPQ 236 (Fed. Cir. 1971)). In *Kroekel* the Court held that “a rejection based on indefiniteness cannot stand simply because the proportions actually recited in the claims may be read in theory to include compositions that are impossible in fact to formulate.” *Kroekel* at 612. Likewise, it is urged that the present claims are not indefinite because of the alleged possibility that the various indicies might be manipulated so that the resulting copolymer is not an oxyalkylene alkylglycol-alkylene ether or a polyoxyalkylene oxide alkenyl ether. As the Court stated in *Shatter Proof Glass*, “if the claim reads in light of the specification reasonable appraise those skilled in the art both the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the Courts can demand no more,” *Shatter Proof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985).

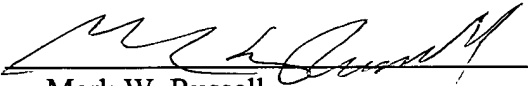
Moreover, it is a well established principle that “when claims are amenable to more than one construction, they should when reasonably possible be interpreted so as to preserve their validity.” *Modine Mfg. Co. v. United States Int’l Trade Comm’n*, 37 USPQ2d 1609, 1671 (Fed.

Cir. 1996). Thus, even if it were discovered that it was possible that one could manipulate the various indicies and variables so that the resulting copolymer was not an oxyalkylene-glycol alkenyl ether or a polyalkylene oxide alkylene ether, the claim should be interpreted to exclude such a compound in order to preserve its validity. Thus, in view of the forgoing reconsideration and withdrawal of this rejection is requested.

Favorable action is earnestly solicited.

Respectfully submitted,

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